

REMARKS

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (*i.e.*, Claims 26-33, 35-37, 39-41, 43, 46, 48-56, 59-61, 63, 64, 67, 70, 72 and 73) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, Applicant and his Attorney wish to thank the Examiner for her allowance of independent Claims 70 and 72, and her indication of the allowability of the subject matter of dependent Claims 34, 35, 68 and 69, as presented in the *Amendment in Response to the Third Office Action*, filed February 21, 2007.

By the present claim amendments, Applicant has incorporated the subject matter of dependent Claim 34 into independent Claim 26, thereby effectively presenting Claim 34 in independent form. (The dependency of Claim 35 has been appropriately amended.) Applicant has also cancelled dependent Claim 68 and incorporated the subject matter thereof into independent Claim 67 for the purpose of rewriting the subject matter of Claim 68 in independent form. Dependent Claim 69 has been cancelled and rewritten as new independent Claim 73.

In view of the foregoing amendments, it is respectfully submitted that Claims 26-33, 35-37, 39, 67 and 73 are in now in condition for allowance. (The obviousness-type double patenting rejection of Claims 26 and 67, as well as the 35 U.S.C. §103(a) obviousness rejection of Claims 26-33, 36, 37, 39, 66, 67 and 71, are submitted to now be

moot.)

As part of the fourth Office Action, the Examiner has rejected Claims 40-65, pursuant to 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, or as not being enabled or sufficiently supported by Applicant's originally-filed Specification. In response to the Examiner's §112, first paragraph, rejection, Applicant has canceled Claims 42, 44, 45, 47, 57, 58, 62 and 65.

Addressing the Examiner's 35 U.S.C. §112, first paragraph, non-enabling rejection of the remaining claims so rejected:

Independent Claims 40, 48, 54, 59, 63 and 64 have been rejected on the ground that these claims, as previously amended on February 21, 2007, were not supported by Applicant's Specification because the enumerated claims recited that the secondary game award amount was equal to the "total jackpot" paid out multiplied by a multiplier value. As the Examiner correctly explains, Applicant's Specification teaches that an individual player's award, which is a relatively small fraction of the total jackpot paid out by the "house," is to be multiplied by a multiplier value.

In light of the Examiner's comments set forth in the non-enablement rejection, Applicant has amended the final sub-paragraph of Claim 40 to clarify that the secondary game award amount is equal to the product of "an individual game award amount multiplied by a multiplier value" and, further, that the "individual game amount [is] a fraction of a total jackpot paid and defined as an amount awarded to an individual entrant having a winning entry when the multiplier value is 1." An amendment similar to that

entered into Claim 40 has also been entered into the last sub-paragraph of each of independent Claims 48, 54, 59, 63 and 64.

The Examiner has further rejected independent method Claim 48 as being non-enabled on the contention that the ordering of the method steps of Claim 48 is not supported by the originally-filed Specification, because the step of “allocating a multiplier value” is recited prior to the step of “determining whether a winning outcome is achieved.” Applicant respectfully disagrees with this basis for rejection.

The “transitional clause” of independent method Claim 48 recites “the method comprising the steps of,” as opposed to imposing any limitation on the ordering of the method steps, as would be the case had the claim’s transitional clause read: “the method comprising the steps *in the order of*.” In *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869 (Fed. Cir. 2003), the Federal Circuit reversed a district court’s claim construction by observing that:

“The district court held that, even though the claims did not recite a specific order, the ‘setting’ step must occur after the ‘testing automatically’ step and before the ‘booting normally’ step. The district court so concluded because the ‘specification consistently indicates that the ‘setting’ step must precede the ‘booting normally’ step. [citation omitted] Altiris argues that the ‘setting’ step can occur before, after, simultaneously with, or between any of the other steps, because the plain meaning of the language of the claims imposes no order. Essentially, Altiris argues the district court ran afoul of our prohibition against importing a limitation from the specification into the claims – here the order of steps used by the sole, preferred embodiment. We agree.”

Applicant respectfully contends that, because independent Claim 48 recites no limitation on the ordering of the method steps recited therein, the claim is not limited to any particular order for performing the steps of Claim 48. Rather, the order of the steps of

independent Claim 48 can be performed in any logical order with all such orderings being within the scope of the claim.

In view of the foregoing, it is respectfully contended that the Examiner's 35 U.S.C. §112, first paragraph, non-enablement rejection, as it pertains to now-pending Claims 40, 41, 43, 46, 48-56, 59-61, 63 and 64, has been overcome and should be appropriately withdrawn.

In light of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (*i.e.*, Claims 26-33, 35-37, 39-41, 43, 46, 48-56, 59-61, 63, 64, 67, 70, 72 and 73) recite a novel method and related apparatus for playing a gambling game, which is patentably distinguishable over the prior art. Accordingly,

withdrawal of the outstanding rejections and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

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The Commissioner for Patents is hereby authorized to charge the Deposit Account of Applicant's Attorney (*Account No. 19-0450*) for any fees or costs pertaining to the prosecution of the above-identified patent application, but which have not otherwise been provided for.